REMARKS

Reconsideration of the application is respectfully requested in view of the amendments and the remarks presented below. The amendments are supported by the application as filed and no new matter has been added by any of the amendments.

Amendments to the claims

Claims 13, 14, 20, 22, 36, and 41 have been amended to correct minor informalities, as discussed below in connection with the objection to the claims. Claim 39 has been amended to correct an obvious error (the use of "removable" when "portable" was intended).

Claims 1-44 are now present in this application.

Amendments to the specification

The specification is amended at page 10 and in the abstract, as discussed below in connection with the objections to the drawings and specification.

Discussion

A.   The Objection to the Drawings

The Examiner objected to the drawings because of the "mislabeling of Figure 21," explaining that "among the drawing sheets there is a figure labeled 'Fig. 22' which matches the description of Figure 21."

The Examiner is referred to the amendments to the drawings submitted with the preliminary amendment filed on February 5, 2002. The sheets of drawings were amended and resubmitted as replacement sheets. The amendment to the last two sheets of drawings (sheets 17 and 18)changed the label for the figure on these sheets from "Fig. 22" and "Fig. 22 (cont.)" to "Fig. 21" and "Fig. 21 (Cont.)," respectively. The Examiner is respectfully reminded of Applicants' request for approval of the amendments to the drawings stated in the preliminary amendment of February 5, 2002.

B.   The Objections to the Specification

The abstract has been amended to correct the informalities noted by the Examiner.

The hyperlink has been deleted from page 10 of the specification, as required by the Examiner.

The Examiner's observations on the use of trademarks in the specification are appreciated.

It is respectfully submitted that the objections to the specification have been overcome and should be withdrawn.

C.   The Objections to the Claims

The Examiner objected to claims 13, 14, 20, 36, and 41 due to punctuation errors. These claims have been amended to correct the punctuation errors.

The Examiner objected to claim 22 because it contained repeated words. This claim has been amended to remove the redundant words.

It is respectfully submitted that the objections to the claims have been overcome and should be withdrawn.

D.   The Rejection of Claims 1-15, 18-22, 24, and 26-44 over Muftic

The Examiner rejected Claims 1-15, 18-22, 24, and 26-44 under 35 USC 102(e) as being anticipated by U.S. Patent 5,943,423 to Muftic ("Muftic").

This rejection includes all of the pending independent claims, *viz.* 1, 18, 20, 26, 27, 39, and 41.

1.   Independent claims 1, 18, and 27 for a "computing platform"

Starting with independent claims 1, 18, and 27, the Examiner stated that Muftic disclosed each limitation in the claimed computer system by reference to the language of claim 1.

This is not the case. Muftic clearly does not teach or suggest at least the following limitations of claims 1, 18, and 27.

a.   portable trusted module

claim 1: "a portable trusted module containing a user identity, wherein a trusted module is a component adapted to behave in an expected manner and resistant to unauthorized external modification";

claim 18: "a portable trusted module containing a user identity, wherein a trusted module is a component adapted to behave in an expected manner and resistant to unauthorized external modification"; and

claim 27: "a trusted module is a component adapted to behave in an expected manner and resistant to unauthorised external modification."

The "portable trusted module" limitation is not taught or suggested by Muftic. The Examiner notes that "[p]erforming 'cryptographic functions and transformations' assists in protecting the contents found in the trusted module ('smart token')." Muftic discloses the use of smart cards "programmed to perform cryptographic functions and transformations based on at least one cryptographic algorithm," col. 3, lines 40-42, and "generating transactions [with the use of a smart card and a smart card reader] which are at least partially encrypted and/or digitally signed," col. 4, lines 1-2. This is not a disclosure of a "trusted module" that is a "component adapted to behave in an expected manner and resistant to unauthorized external modification."

b.   access profile

claim 1:"an access profile specifying license permissions of users with respect to the data";

claim 18: "an access controller for specifying license permissions of users with respect to the data and for enabling use of the data"; and

claim 27: "access profile specifying license permissions of users with respect to the data."

The Examiner states that Muftic teaches "an access profile specifying license permissions of users with respect to the data" at col. 5, lines 48-54. This is not the case. The cited section of Muftic states that activities in a computing environment are authorized "only to those persons authorized to engage in the activity by opening an authorization credentials application domain on a smart token; scanning a plurality of authorization credentials stored therein for an authorizing credential; and if an authorizing credential is found, authorizing the activity." *See also* Muftic,

Figs. 20 and 21 and col. 15, line 66 - col. 16, line 34. It is clear that Muftic teaches the binding of a key pair to license-related software and to a particular user identity. *See, e.g.,* Muftic at col. 5, line 55-col. 6, line 4. This is not "an access profile specifying license permissions of **users**" or "an access controller for specifying license permissions of **users**" (emphasis supplied).

In Muftic the software is bound specifically to one user identity and cannot be used by others, whereas in the claimed invention "the secure operator is adapted to check the access profile to determine whether a requested operation is licensed for the user identity contained in the portable trusted module and prevent the requested operation if a license is required and not present" (quoting claim 1, see also claim 18 ("wherein the access controller is adapted to determine whether a requested operation is licensed for the user identity contained in the portable trusted module and prevent the requested operation if a license is required and not present" and claim 27 ("wherein the secure operator is adapted to check the access profile to determine whether a requested operation is licensed for a user identity contained in a portable trusted module in communication with the computer platform")).

To anticipate a claim, the reference must teach every element of the claim and the elements in the reference must be arranged as required by the claim. M.P.E.P. § 2131. Muftic does not teach or suggest at least the limitations quoted from claims 1, 18, and 27. The Section 102(e) rejection of these claims over the Muftic reference should be withdrawn for at least this reason.

2.   Dependent claims 2 and 28

Claims 2 and 28 depend, respectively, from independent claims 1 and 27 and add the following limitations:

claim 2: "wherein the computer platform further comprises a platform trusted module, and wherein the platform trusted module and the portable trusted module are adapted for mutual authentication," and

claim 28: "further comprising a platform trusted module, and wherein the platform trusted module and the portable trusted module are adapted for mutual authentication."

Claim 1 defines a "trusted module" in the limitation "wherein a trusted module is a component adapted to behave in an expected manner and resistant to unauthorized external modification." This limitation is included in claim 2 with respect to the "platform trusted module."

Claim 27 defines a "trusted module" in the limitation "a trusted module is a component adapted to behave in an expected manner and resistant to unauthorised external modification." This limitation is included in claim 28 with respect to the "platform trusted module."

In general, Muftic does not teach or suggest the provision of a secure entity on a computer platform. Thus, Muftic does not disclose a platform trusted module as that term is defined in the claims. The Examiner refers to Fig. 1, col. 3, lines 46-61, col. 5, lines 30-47, and col. 7, lines 61-67, col. 8, lines 1-23 of Muftic as disclosing this limitation. However, neither these parts of Muftic's disclosure nor any others contain any reference to "platform trusted modules" that are "component[s] adapted to behave in an expected manner and resistant to unauthorized external modification."

The Section 102(e) rejection of claims 2 and 28 over the Muftic reference should be withdrawn.

3.   Dependent claims 3, 29, and 42

Claims 3, 29, and 42 depend, respectively, from dependent claims 2, 28, and 41, and add the following limitations:

claim 3: "wherein some or all of the functionality of the secure operator is within the platform trusted module";

claim 29:" wherein some or all of the functionality of the secure operator is within the platform trusted module"; and

claim 42: "wherein the computer platform further comprises a platform trusted module, and wherein some or all of the functionality of the access controller is within the platform trusted module."

Muftic does not disclose a computing platform in which "some or all of the functionality of the secure operator is within the platform trusted module." The Examiner refers to col. 3, lines 46-61 and col. 4, lines 1-5 of Muftic as disclosing this limitation. However, these parts of Muftic's disclosure contain no reference to such a teaching. Nor could they do so because, as noted above, Muftic does not teach or suggest a "platform trusted module."

The Section 102(e) rejection of claims 3, 29, and 42 over the Muftic reference should be withdrawn.

4.   Independent claim 20 for a method

The Examiner stated that Muftic disclosed each limitation in the method of claim 20. This is not the case. As discussed above in connection with claim1, Muftic does not teach or suggest at least the following limitations in the system with which the method is used: "a portable trusted module containing a user identity, wherein a trusted module is a component adapted to behave in an expected manner and resistant to unauthorized external modification," and "an access profile specifying license permissions of users with respect to the data."

In addition, Muftic clearly does not teach or suggest at least the following step limitations of claim 20:

> a.   *"a request for a policy check by the operating system of the computer platform to the secure operator before acting upon the data, by sending to the secure operator the   name of the target data plus the intended operation"*

The Examiner refers to col. 9, lines 47-57 and col. 10, lines 38-41 of Muftic as disclosing this limitation. However, these parts of Muftic's disclosure merely refer to file structures in the smart token (col. 9, lines 47-57: "[i]nternally in the token, data are called elementary objects" that "may be organized in groups that are called elementary files," etc.; col. 10, lines 38-41: "application ID file 455 is a file containing the name and other characteristics of the application which uses a specific type of smart tokens").

> b.   *"the secure operator checking the restrictions associated with the target data in the access profile to determine whether the data may be operated upon"*

The Examiner refers to col. 5, lines 55-67 and col. 6, lines 1-4 and 19-41 of Muftic as disclosing this limitation. However, Muftic does not teach or suggest access profiles in these or other sections of his disclosure, as discussed above in connection with claims 1, 18, and 27.

The Section 102(e) rejection of claim 20 over the Muftic reference should be withdrawn.

5.   Independent claim 26 for a method

The Examiner stated that Muftic disclosed each limitation in the method of claim 26. This is not the case. As discussed above in connection with claims 2 and 28, Muftic does not teach or suggest at least the following limitations in the computer platform with which the method is used: "a platform trusted module wherein a trusted module is a component adapted to behave in an expected manner and resistant to unauthorised external modification." In addition, the "data

protector for checking data integrity before a processor of the computer platform carries out operations on the data" is not disclosed by Muftic in either of the sections cited by the Examiner or elsewhere.

In addition, Muftic clearly does not teach or suggest at least the following step limitations of claim 26:

    a.   *"verification of the reliability of the data before installation of the data and an associated access profile"*

This limitation is not disclosed by Muftic in either the sections cited by the Examiner (col. 8, lines 61-67 and col. 9, lines 1-17 and 40-57) or elsewhere. The Examiner is invited to state more precisely where and why he believes that it is disclosed in Muftic.

    b.   *"loading of a digest of protected data and an associated access profile into the platform trusted module, whereby the digest is used by the data protector and/or secure operator before execution of the data"*

This limitation is not disclosed by Muftic in either the sections cited by the Examiner (col. 8, lines 61-67 and col. 9, lines 1-17 and 40-57) or elsewhere. The Examiner is invited to state more precisely where and why he believes that it is disclosed in Muftic.

The Section 102(e) rejection of claim 26 over the Muftic reference should be withdrawn.

6.   Independent claim 41 for a method

The Examiner stated that Muftic disclosed each limitation in the method of claim 41. This is not the case. As discussed above in connection with claims 1, 18, and 27, Muftic does not teach or suggest at least the following limitation in the system with which the method is used: "a portable trusted module containing a user identity, wherein a trusted module is a component adapted to behave in an expected manner and resistant to unauthorised external modification."

In addition, Muftic clearly does not teach or suggest at least the following step limitations of claim 41:

    a.   *"a request for a policy check by the operating system of the computer platform to the access controller before acting upon the data, by sending to the access controller the name of the target data plus the intended operation"*

This limitation is not disclosed by Muftic in either the sections cited by the Examiner (col. 9, lines 47-57 and col. 10, lines 38-41) or elsewhere. Muftic does not disclose an "access

controller" in the computer platform. The Examiner is invited to state more precisely where and why he believes that it is disclosed in Muftic.

b.   *"the access controller checking the restrictions associated with the target data to determine whether the data may be operated upon"*

This limitation is not disclosed by Muftic in either the sections cited by the Examiner (col. 5, lines 55-67 and col. 6, lines 1-4, 19-31) or elsewhere. Muftic does not disclose an "access controller" in the computer platform. The Examiner is invited to state more precisely where and why he believes that it is disclosed in Muftic.

c.   *"replying to the operating system"*

This limitation is not disclosed by Muftic in either the sections cited by the Examiner (col. 5, lines 48-54 and col. 6, lines 25-31) or elsewhere. Muftic does not disclose an "access controller" in the computer platform that can reply to the operating system. The cited sections of Muftic refer to the smart token or to a desired result without disclosing how to accomplish it. The Examiner is invited to state more precisely where and why he believes that it is disclosed in Muftic.

The Section 102(e) rejection of the claim 41 over the Muftic reference should be withdrawn.

7.   Independent claim 39 for a portable trusted module

The Examiner stated that Muftic disclosed each limitation in the portable trusted module of claim 39. This is not the case. As discussed above in connection with claims 1, 18, and 27, Muftic clearly does not teach or suggest at least the following limitations of claim 39: "wherein a trusted module is a component adapted to behave in an expected manner and resistant to unauthorised external modification; the portable trusted module containing a user access license specifying access rights to data associated with the removable trusted module."

The Section 102(e) rejection of claim 39 over the Muftic reference should be withdrawn.

8.   **The remaining dependent claims rejected over Muftic: claims 4-**
15, 19, 21, 22, 24, 30-38, 40, and 42-44

Claims 4-15, 19, 21, 22, 24, 30-38, 40, and 42-44 are dependent on claims discussed above. The rejection of these claims over Muftic should be withdrawn at least because the claims from which they depend have been shown to be not anticipated by Muftic.

E.   **The Rejection of Claims 16 and 25 over Muftic and further in view of**
Smithies, et al.

The Examiner rejected claims 16 and 25 under 35 USC 103(a) as being unpatentable over Muftic as applied to claims 2 and 21 above (respectively) and further in view of U.S. Patent 6,091,835 to Smithies, et al. ("Smithies, et al.").

Claims 16 and 25 depend from claims that have been shown to be not anticipated by Muftic (claims 2 and 20 (and thus 21). The use of Smithies, et al. to modify Muftic, whether or not permissible (Applicants do not concede this issue) would not teach or suggest the combination of limitations of claims 16 and 25. The rejection of claims 16 and 25 as being unpatentable over Muftic in view of Smithies, et al. should be withdrawn, at least because of their dependency on claims 2 and 21.

F.   **The Rejection of Claim 17 over Muftic and further in view of Smithies, et al.**

The Examiner rejected claim 17 under 35 USC 103(a) as being unpatentable over Muftic as applied to claims 6 above and further in view of Smithies, et al.

Claim 17 depend from claims that have been shown to be not anticipated by Muftic (claims 1 and 6). The use of Smithies, et al. to modify Muftic, whether or not permissible (Applicants do not concede this issue) would not teach or suggest the combination of limitations of claim 17. The rejection of claim 17 as being unpatentable over Muftic in view of Smithies, et al., should be withdrawn, at least because of its dependency on claim 6.

G.   **The Rejection of Claim 23 over Muftic and further in view of Pare**

The Examiner rejected claim 23 under 35 USC 103(a) as being unpatentable over Muftic as applied to claim 21 above and further in view of U.S. Patent 5,870,723 to Pare ("Pare").

Claim 23 depend from claims that have been shown to be not anticipated by Muftic (claims 20 and thus 21). The use of Pare to modify Muftic, whether or not permissible (Applicants do not concede this issue) would not teach or suggest the combination of limitations of claim 23. The rejection of claim 23 as being unpatentable over Muftic in view of Pare should be withdrawn, at least because of its dependency on claims 20 and 21.

H.   The Provisional Rejection of Claim 27 for Double Patenting

The Examiner provisionally rejected claim 27 under 35 USC 101 as claiming the same invention as that of claim 27 of co-pending application No. 10/049,211 (the "'211 application"). The instant application is the "'213 application." The provisional rejection for "same invention" or "statutory" double patenting" should be withdrawn because the identical subject matter is not defined by both claims.

The M.P.E.P., at Section 804, part II.A, states:

A. Statutory Double Patenting - **35 U.S.C. 101**

In determining whether a statutory basis for a double patenting rejection exists, the question to be asked is: Is the same invention being claimed twice? 35 U.S.C. 101 prevents two patents from issuing on the same invention. "Same invention" means identical subject matter. *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

A reliable test for double patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without literally infringing a corresponding claim in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)[*Vogel* held that no "same invention" double patenting existed when claims of patent were directed to method of preparing "pork" whereas claims of appealed application were directed to methods for preparing "meat" or "beef" because meat "is not the same thing" as pork and "[b]eef is not the same thing as pork"] Is there an embodiment of the invention that falls within the scope of one claim, but not the other? If there is such an embodiment, then identical subject matter is not defined

by both claims and statutory double patenting would not exist. For example, the invention defined by a claim reciting a compound having a "halogen" substituent is not identical to or substantively the same as a claim reciting the same compound except having a "chlorine" substituent in place of the halogen because "halogen" is broader than "chlorine." On the other hand, claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

The provisional rejection for statutory double patenting should be withdrawn because the *In re Vogel* infringement test shows that the identical subject matter is not defined by the two claims 27.

Claim 27 of the '211 application depends from claim 20 that in turn depends from claim 1. Claim 1 of the '211 application contains, *inter alia*, the following limitation: "[a] computer platform having: a trusted module which is resistant to internal tampering and which stores a third party's public key certificate." This limitation comes before the "a further, removable, trusted module containing a user identity" added by claim 27 of the '211 application.

Claim 27 of the instant '213 application does not contain this limitation. It does contain a limitation directed to "a portable trusted module in communication with the computer platform, wherein a trusted module is a component adapted to behave in an expected manner and resistant to unauthorised external modification," but the "portable trusted module" of claim 27 of the instant '213 application is not a part of the computer platform and therefore is not substantively the same as the "trusted module" in the computer platform of claim 27 of the '211 application.

Accordingly, and without considering the other limitations, a computer platform lacking a "trusted module" or its equivalent in its computer platform could infringe claim 27 of the instant '213 application but would not infringe claim 27 of the '211 application.

The *In re Vogel* test therefore indicates that this is not a case of statutory double patenting. The provisional double-patenting rejection should be withdrawn.

Conclusion

Claims 1-44 are allowable because the rejections over Sections 101, 102(e), and 103(a) and the objections have been overcome as described above.

In view of the above, the Applicants submit that the application is now in condition for allowance and respectfully urge the Examiner to pass this case to issue. The Examiner is invited to telephone the undersigned attorney as needed in order to advance the examination of this application.

* * *

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on
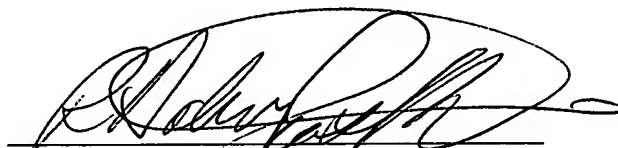
February 6, 2006
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(Date of Transmission)

Jane Penzell
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